

B1-4171

REMARKS

Claims 7-8, 10-17, 20, 22-23, 27, 30, 36, 38, and 41-46 are in the case. Claims 18 and 21 are objected to and claims 1 and 18 are rejected under 35 USC § 112. Claims 1-40 are rejected under 35 USC § 103. Claims 7-8, 10-17, 20, 22-23, 27, 30, 36, and 38 have been amended and claims 1-6, 9, 18-19, 21, 24-26, 28-29, 34-35, 37, and 39-40 have been cancelled. New claims 41-46 have been added. No new matter has been introduced by the amendments, which are supported by the disclosure of the original claims and the specification. Reconsideration and allowance of the claims are respectfully requested.

DECLARATION OBJECTIONS

The declaration is objected to because the citizenship for co-inventor Mary Albanese was inadvertently omitted from the original declaration. Ms. Albanese has executed a general declaration of her citizenship, which is provided herewith. Withdrawal of the objection is respectfully requested.

DRAWING OBJECTIONS

Figure 1 of the drawings is objected to because label 110 generally indicates the entire figure. Figure 1 has been revised in the manner suggest by the examiner to be consistent with the other drawings, with label 100 now indicating only the control program. Withdrawal of the objection is respectfully requested.

SPECIFICATION OBJECTIONS

The specification is objected to because it does not contain a definition of a term used in claim 18. Claim 18 has been canceled. Withdrawal of the objection is respectfully requested.

CLAIM OBJECTIONS

Claim 21 is objected to for informalities. Claim 21 has been canceled. Withdrawal of the objection is respectfully requested.

B1-4171

CLAIM REJECTIONS UNDER §112

Claim 18 is rejected for reciting language that was not defined in the specification. Claim 18 has been canceled.

Claim 1 is rejected for being indefinite. Claim 1 has been canceled. Withdrawal of the objections is respectfully requested.

CLAIM REJECTIONS UNDER §103

Claims 1-40 were rejected over various combinations of Kuo et al., Redmond, Baker et al., Trinh et al., Willmann et al., Wegrzyn, Todd et al., Schwaller et al., Gee, Iwasawa et al., Alfernness et al., and "official notice." The independent claims and many of the original dependent claims have been canceled, and the remaining dependent claims have been amended to depend from the new independent claims 41 and 42. These new independent claims patentably define over the various combinations of the cited references for the reasons briefly given below.

None of Kuo et al., Schwaller et al., Redmond et al., Baker et al., Willmann et al., Wegrzyn, Gee, and Iwasawa et al., nor their combination, describe only one control process, where the control process, client process, and the server process are separate and distinct processes, all messaging between the server process and the client process is controlled by the control process, and the control process sets synchronization points where the server process pauses until restarted by the control process.

Applicants assert that it is improper to take official notice of the elements stated in the office action, and that the references are improperly combined, both of which are discussed in greater detail in the following sections.

COMBINATION OF REFERENCES

The present claims are directed toward a novel client-server simulation environment, which uses a server process and a client process that are controlled by a control process. Not only does all communication between the server process and the client process go through the control process, but the control process can pause or stop

B1-4171

both the server process and the client process, such as by using synchronization points. In this manner, a distributed system can be made to simulate an actual server and client.

Thus, the claims recite certain steps or elements in combination. Applicants do not at this time assert the claim that any one of these steps or elements, taken by itself, is novel and has never before been seen. Thus, applicants anticipate that it might be possible to find each and every step or element somewhere in the prior art. Even so, applicants assert that they have combined these possibly-known steps and elements in a novel and nonobvious manner to produce a process that has great benefits.

The examiner has selected a set of prior art references, which arguably contain the steps or elements as recited in the present claims. However, the steps and elements selected by the examiner are used in combination with many other steps and elements that are not used in the present claims. The examiner has selectively extracted from the cited references only those steps and elements that are common with the present claims, and has rearranged those selected steps and elements in a manner where they align to some degree with the presently claimed steps and elements. However, the question must be answered, "what was obvious about selecting that special set of steps and elements from the prior art?" This question has not been answered.

What the examiner has not done, and what the examiner must do, is provide proper motivation for making the selection and combination of prior art steps and elements. Applicants assert that without the proper motivation, the combination of steps and elements as recited by the examiner is not obvious. As noted above, the mere fact that various steps and elements *could be* placed in combination is not a sufficient motivation for actually making the combination. An infinite number of different steps and elements *could be* placed in combination, but in order to make the present combination obvious, there must be an allowable motivation to make the combination.

Similarly, to just recite a benefit of the selected combination is also not sufficient. Almost every combination has one or more benefits of some type. Thus, the fact that a given combination may have a certain benefit in common with many other different combinations does nothing to make that given combination obvious over any of the other combinations. Further, the identified benefits must be obvious from the prior art, and not just in light of the present invention.

B1-4171

Thus, it is respectfully submitted that the references cited do not support combining the elements as claimed in the present invention. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990) states that the PTO erred in rejecting a claimed invention as an obvious combination of the teaching of prior art references when the prior art provided no teaching, suggestion, or incentive supporting the combination. See *Northern Telecom Inc. v. Datapoint Corp.*, 15 U.S.P.Q.2d 1321, 1323, *In re Geiger*, 2 U.S.P.Q.2D 1276, 1278. *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 U.S.P.Q.2d (BNA) 1468, 1475 (Fed. Cir. 1988) states that one "cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention."

There is nothing in the prior art cited to lead a person of ordinary skill to design an apparatus like that of the present invention, other than the hindsight knowledge of this invention. The office action recites certain generalized benefits (realized in hindsight after considering the invention) as motivation for the combination of the references. However, these generalized motivations do not make obvious the combination of the references to produce the claimed invention. Only after considering the invention is it understood that combining the references (and adding a great deal more) tends to produce the motivating elements.

This, however, does not satisfy Section 103. The motivation to combine references cannot come from the invention itself. See *In re Oetiker*, 24 U.S.P.Q.2D 1443, 1446. The claims of the present application appear to have been used as a frame, and individual parts of separate prior art references were employed to recreate a facsimile of the claimed invention. See *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 312. There is no explanation of what there was in the prior art that would have caused those skilled in the art to combine the references.

This problem appears to be especially prevalent in the present rejections, where *combinations of five and six different references are used, in addition to "official notice."* Applicants assert that there is nothing obvious about such combinations that result from so many different references, where portions of the cited systems have been cut and pasted without regard to the architecture of the systems from which they were lifted. Such lengthy combinations make it obvious that the present invention was used as

B1-4171

a template for the construction of the combination. Even still, the inclusion of "official notice" in the combination indicates that, even while using the invention as a template, all of the elements as claimed could not be found in the prior art.

The examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2D at 1438-1439. In the absence of such, applicants respectfully suggest that the references are improperly combined.

OFFICIAL NOTICE

The Federal Circuit stated in *In re Lee* (61 USPQ2nd 1430) that the common knowledge and common sense relied on in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act, and that conclusory statements such as those do not fulfill the agency's obligation. The deficiencies of the cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. Applicants assert that the examiners "official notice" is nothing more than assertions about what is common sense or common knowledge, which is not sufficient for making out a case of obviousness.

CONCLUSION

Applicants assert that the claims of the present application patentably define over the prior art made of record and not relied upon for the same reasons as given above. Applicants respectfully submit that a full and complete response to the office action is provided herein, and that the application is now fully in condition for allowance. Action in accordance therewith is respectfully requested.

In the event this response is not timely filed, applicants hereby petition for the appropriate extension of time and request that the fee for the extension be charged to deposit account 12-2252. If other fees are required by this amendment, such as fees for additional claims, such fees may also be charged to deposit account 12-2252. Should the examiner require further clarification of the invention, it is requested that s/he contact the undersigned before issuing the next office action.

To:

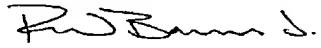
From: Rick Barnes

9/19/2005 11:41:14 (Page 16 of 18)

B1-4171

Sincerely,

LUEDEKA, NEELY & GRAHAM, P.C.

By: 

Rick Barnes, 39,596

2005.09.19

Page 16 of 16